#6 Suppl. Response
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12-17-02
Case 7021

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	
Owen M. PATTERSON	:	Group Art Unit: 3711
Serial No. 09/977,331	:	Examiner: Graham, Mark S.
Filed: October 16, 2001	:	
For: GOLF PUTTING PRACTICE DEVICE	:	

SUPPLEMENTAL RESPONSE

Honorable Commissioner of Patents
and Trademarks
Washington, DC 20231

Dear Sir:

An interview was conducted with the examiner on November 19, 2002 for purposes of discussing the rejection as set forth in the Office Action of July 30, 2002. In view of the interview and supplemental to the Response and Request For Reconsideration filed on October 30, 2002, applicant submits the following.

In the Office Action of July 30, 2002, claims 4, 5, 10-16, 18, 19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Wagner* wherein it is stated that *Wagner* discloses the claimed device with the exception of the dimensions and weight. It is further stated that it is commonly known in the practice putting target art to vary the size/weight of such devices depending on the training method used and it would have been obvious to one or ordinary skilled in the art to have done the same with the *Wagner* target for the same reason.

Reconsideration of this rejection is requested for the following reasons.

It was acknowledged during the interview that the capture disc of *Wagner* is for harvesting and lifting golf balls and is not a target against which a golf ball is hit. The front elevational view of *Wagner* illustrates the intended alignment of the lifting device. Since *Wagner* is not enabling for a target, there can be no *prior art* suggestion for the modification as set forth in the Official Action.

In the alternative, the modification proposed in the Office Action renders the *Wagner* device inoperable for its intended purpose since it cannot function to lift golf balls when disposed on its side. See *In re Gordon et al.*, 221 USPQ 1125 (CAFC 1984) [realignment of pump by turning it upside down held to be improper modification since it rendered the device inoperable for its intended purpose]. It is respectfully asserted the rejection of claims 4, 5, 10-16, 18, 19, 21 and 22 is therefore improper and should be withdrawn.

Claims 2, 7 and 17 have been rejected under 35 U.S.C. 102(e) as being anticipated by *Wagner*. Reconsideration of this rejection is requested because the features recited in these claims are not shown in the applied prior art. Claim 2 recites a substantially flat surface for the truncated cone. The perimeter edge of *Wagner* is arcuate and irregular and not substantially flat. Claim 7 recites a bore having top and bottom shoulders. The central bore

of *Wagner* is smooth and does not include top and bottom shoulders. Claim 17 recites top and bottom portions that are mirror images of each other. The top and bottom surfaces of *Wagner* are not mirror images. They are configured to permit adjacent discs to interconnect in a side by side relation. In view of the above, reconsideration of these rejected claims is respectfully requested.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by *Wagner*. In the Response And Request For Reconsideration as well as during the interview applicant asserted *Wagner* cannot function as an anticipatory reference because it is not enabling for a target. See *Chester v. Miller*, 15 USPQ2d 1336 (Fed. Cir. 1990) and *In re Donohue*, 226 USPQ 619 (Fed. Cir 1985). The examiner disagrees with applicant and cites *In re Schreiber* as providing support for anticipation of claim 1 by *Wagner* notwithstanding the failure of the reference to enable for a target. However, the facts surrounding the *In re Schreiber* decision are readily distinguished from that of the present case. The prior art and the claimed device of *In re Schreiber* were both dispensers (oil and popcorn respectively) and the court had little trouble in finding that the prior art oil dispenser *enabled for use* as a popcorn dispenser. In addition, the court stated that nothing in the disclosure of the prior art reference suggested it was limited for use as an oil dispenser. See *In re Schreiber*, 44 USPQ2d at 1433. In the present application, the *Wagner* disc as

depicted in the front elevation view of the drawings is not intended to rest on its side. As shown in the *Tucek* device cited in *Wagner*, a golf ball capture disc is incorporated into a golf ball retriever utilizing a number of spaced capture discs mounted on a common shaft, the spacing of the capture discs corresponding to the width of a golf ball so that as the capture discs move over a ground surface, golf balls are caught between adjacent capture discs. The *Wagner* capture disc does suggest a use other than as golf ball lifting device. Accordingly, the capture disc of *Wagner* does not enable for a target and therefore is not an anticipatory reference.

In view of the above, it is respectfully requested a Notice of Allowance be issued with respect to all the claims as filed.

It is believed no fees are due; however, should that determination be incorrect, charge the deficiencies to Deposit Account No. 19-2105 and notify the undersigned in due course.

Respectfully submitted,

Date: 12/10/02

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